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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,136	03/27/2001	Darrell C. Conklin	00-25	3811

7590

04/05/2002

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EXAMINER

RAMIREZ, DELIA M

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 04/05/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/819,136

Applicant(s)

CONKLIN ET AL.

Examiner

Delia M. Ramirez

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1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 1/23/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8,23,24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6,23,24 and 26 is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Status of the Application***

Claims 1-8, 23-24 and 26 are pending.

Applicant's election without traverse of Group I, claims 1-8, 23-24 drawn to a protease inhibitor according to SEQ ID NO: 2, cancellation of claims 9-22 and 25, amendment of claims 23-24, and addition of claim 26 in Paper No. 7, filed on 1/23/2002 is acknowledged.

### ***Drawings***

1. The drawings have been reviewed and are objected under 37 CFR 1.84 or 1.152. See attached Notice of Draftsperson's Patent Drawing Review. Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

### ***Claim Rejections - 35 USC § 112, First Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Claim 8 is directed to genera of polypeptides of any function comprising fragments of at least 15 amino acids of SEQ ID NO: 2, wherein those fragments comprise residues 117-122, 525-530, 283-288, or 50-55. According to the specification, the polypeptide of SEQ ID NO: 2 encodes a novel human Kunitz-type proteinase inhibitor Zkun6 (page 8, lines 29-32; one function). The specification discloses that the polypeptide of SEQ ID NO: 2 contains several fragments which correspond to domains A-G, as listed in Table 1, page 9 of the specification. Applicants predict that the domains disclosed in Table 1 correspond to motifs characteristic of different types of proteins. No information beyond the disclosure of SEQ ID NO: 2 and the domains listed in Table 1 has been provided by Applicant which would indicate possession of the claimed genera of polypeptides.

The specification does not disclose the function of proteins comprising the different fragments as encompassed by the claim. In addition, one of skill in the art cannot accurately predict the function of the polypeptides encompassed by the claim solely on sequence comparison with proteins of known function, as disclosed in the specification. The state of the art teaches that sequence comparison alone should not be used to determine a protein's function and that small amino acid changes can drastically change the function of a polypeptide. Bork (Genome Research, 10:348-400, 2000) teaches protein function is context dependent, and both molecular and cellular aspects must be considered (page 398). Van de Loo et al. (Proc. Natl. Acad. Sci. 92:6743-6747, 1995) teaches that polypeptides of approximately 67% homology to a desaturase from *Arabidopsis* were found to be hydroxylases once tested for activity. Broun et al. (Science 282:1315-1317, 1998) teaches that as few as four amino acid substitutions can convert an oleate 12-desaturase into a hydrolase and as few as six amino acid substitutions can

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transform a hydrolase to a desaturase. Many functionally unrelated polypeptides are encompassed within the scope of these claims. The specification only discloses a single species of the claimed genera which is insufficient to put one of ordinary skill in the art in possession of the attributes and features of all species within the claimed genera. Thus, one skilled in the art cannot reasonably conclude that Applicant had possession of the claimed invention at the time the instant application was filed.

3. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the polypeptide of SEQ ID NO: 2 and the domains within the polypeptide of SEQ ID NO: 2 as listed in Table 1 of the specification, does not reasonably provide enablement for any polypeptide of any function comprising a fragment of at least 15 amino acids of SEQ ID NO: 2, wherein the fragments comprise residues 117-122, 525-530, 283-288, or 50-55. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The criteria for undue experimentation, summarized in *re Wands*, 8, USPQ2nd 1400 (Fed. Cir. 1988) are: 1) quantity of experimentation necessary, 2) the amount of direction or guidance presented, 3) the presence and absence of working examples, 4) the nature of the invention, 5) the state of prior art, 6) the relative skill of those in the art, 7) the predictability or unpredictability of the art, and 8) the breadth of the claims.

Claim 8 is so broad as to encompass any polypeptide comprising fragments of at least 15 amino acid residues of SEQ ID NO: 2. The scope of the claims is not commensurate with the enablement provided by the disclosure with regard to the extremely large number of

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polypeptides of unknown function broadly encompassed by the claim. While the specification discloses the sequence and function for the polypeptide of SEQ ID NO: 2 and its domains as listed in Table 1 of the specification, no information is provided as to the function of polypeptides comprising fragments of at least 15 amino acids of SEQ ID NO: 2 wherein the fragments comprise residues 117-122, 525-530, 283-288, or 50-55. No function has been disclosed for the residues 117-122, 525-530, 283-288, or 50-55. No examples of other polypeptides comprising the fragments recited in the claims with the desired function are disclosed either.

The current state of the art indicates that small amino acid changes can drastically change the function of a polypeptide. In addition, it is known in the art that sequence identity alone is insufficient to accurately predict function. See, for example, the teachings of Van de Loo et al. (Proc. Natl. Acad. Sci. 92:6743-6747, 1995) and Broun et al. (Science 282:1315-1317, 1998), already discussed. The amino acid sequence of the polypeptide determines its structural and functional properties, therefore, one of skill in the art would require some knowledge and guidance as to how structure is related to function in order to determine if a polypeptide comprising a fragment of at least 15 amino acids of SEQ ID NO: 2 wherein the fragment comprises the residues 117-122, 525-530, 283-288, or 50-55 has proteinase inhibitor activity. Therefore, due to the lack of relevant examples, the amount of information provided, the lack of knowledge about the critical structural elements required to maintain the desired function, and the unpredictability of the prior art in regard to function based on homology, one of ordinary skill in the art would have to go through the burden of undue experimentation in order to screen and isolate those molecules, as encompassed by the claim, with proteinase inhibiting activity.

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Thus, Applicant has not provided sufficient guidance to enable one of ordinary skill in the art to make and use the invention in a manner reasonably correlated with the scope of the claims.

#### *Double Patenting*

4. Applicant is advised that should claim 1 be found allowable, claim 7 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

#### *Allowable Subject Matter*

5. Claims 1-7, 23-24, and 26 appear to be free of the prior art.

#### *Conclusion*

6. Applicants are requested to submit a clean copy of the pending claims (including amendments, if any) in future written communications to aid in the examination of this application.

7. Certain papers related to this application may be submitted to Art Unit 1652 by facsimile transmission. The FAX number is (703) 308-4556. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94

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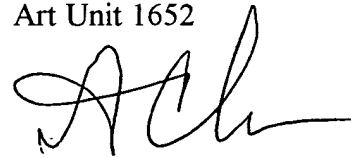
(December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If Applicant submits a paper by FAX, the original copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (703) 306-0288. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (703) 308-3804. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

DR  
April 1, 2002

Delia M. Ramirez, Ph.D.  
Patent Examiner  
Art Unit 1652



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